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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/521,795 | 10/27/2005 | Bernhard Nellessen | 745691-35 | 1968 |
| 22204 7590 04/09/2008 NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128 | | | | |
| EXAMINER | | | | |
| CORDRAY, DENNIS R | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1791 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

| | |
|--------------------------------------|---|
| Application No. 10/521,795 | Applicant(s) NELLESSEN ET AL. |
| Examiner DENNIS CORDRAY | Art Unit 1791 |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 March 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 20 March 2008. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: 6 and 17
Claim(s) rejected: 1-5, 7-16 and 18-29
Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

/Eric Hug/
Primary Examiner

/Dennis Cordray/
Examiner, Art Unit 1791

Continuation of 3. NOTE: Dependent claims 7-11, 14 and 17-27 depend from amended Claim 1 and present additional combinations and limitations due to the amendments to Claim 1 that were not previously presented. The new combinations require further searching and consideration with regard to indefiniteness issues and the prior art.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that that the disclosures of Mollett and Richmann are general disclosures that do not suggest or teach the claimed HLB. Each of the disclosures of Mollett and Richmann embodies the broadly claimed polysiloxanes comprising polyalkoxylated substituents. Absent convincing evidence of unexpected properties distinguishing the claimed polysiloxanes from the broader disclosures of Mollett and Richmann, each reference is deemed to anticipate the claimed polysiloxanes with sufficient specificity or, at least, makes them obvious to one of ordinary skill in the art as functionally equivalent options. In the embodiments overlapping the claims of the instant invention, the disclosed alkoxyated polysiloxanes will have the claimed HLB because, where the claimed and prior art apparatus or product are identical or substantially identical in structure or composition, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). In other words, when the structure recited in the reference is substantially identical to that of the claims, the claimed properties or functions are presumed to be inherent.

Regarding the arguments against Richmann as disclosing flotation as incompatible with the claimed invention, Richmann teaches that traditional deinking processes utilize a wide variety of surfactants and dispersants having a high HLB generally, but not necessarily, greater than 10 to wet and disperse ink particles to a size range of about 0.5 to 15 microns, which allows for their most efficient subsequent removal by washing and/or froth flotation processes (col 1, lines 61-66). The disclosed invention uses a surfactant having an HLB from 0.5 to 10, which significantly enhances the aggregation of electrostatic toner particles and allows their separation through centrifugal cleaning or screening (col 2, lines 17-24). At no time does Richmann teach that flotation can not be used or discourage the use of flotation with the disclosed process, but teaches instead that additional methods of separation are usable. One of ordinary skill in the art would have found it obvious to use flotation as a well known traditional method of separation and a functionally equivalent option.

The evidence presented by applicant has been considered but is not convincing. Only three example siloxanes, A, D and H, fall within the bounds of the instant claims and the claims that embody these examples, claims 6 and 17, have been indicated as being allowable, although they are objected to for being dependent on a rejected claim. Example siloxane G, which Applicant indicates as being an inventive siloxane, has 13.7 ethylene oxide (EO) and 3.3 propylene oxide (PO) units as indicated by parameters x and y in Table 1. However, Claim 1 indicates that the number of alkoxide units of each species (parameters q and s) must be zero or an integer. In addition, siloxane G has an HLB of 8.5 as indicated in Table 3, which value fall outside of the claimed range (Claim 14).

The rejections are maintained.

Continuation of 13. Other: Note the attached Information Disclosure Statement, which has been considered by the Examiner.